

## AMENDMENT &amp; RESPONSE UNDER 37 C.F.R. § 1.116 - EXPEDITED PROCEDURE

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Serial Number: 09/002.584

Dkt: 450.222US1

Filing Date: January 5, 1998

Title: SYSTEM FOR SCHEDULED CACHING OF IN-BAND DATA SERVICES

44. The computerized system of claim 1 wherein the electronic program guide data originates from multiple sources.

45. The computerized system of claim 1 wherein the user initiated scheduling process is capable of causing the real time scheduling process to schedule multiple executions of the caching process.

### REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on July 18, 2002, and the references cited therewith.

No claims are amended, canceled, and or added; as a result, claims 1-6, 9-13, 15-19, 21-23, 25, 28-32, 35-36, 39-40, and 43-45 are now pending in this application.

### §103 Rejection of the Claims

Claims 1-5, 7, 9-23, 25-27, 29-30, 32-34, 36-38 and 40-42 were rejected under 35 USC § 103(a) as being unpatentable over Young (US 5,353,121) in view of Ohga (US 5,465,385), Metz (US 5,666,293) and Marsh (US 6,208,799). Applicant respectfully traverses the rejection. Further, Applicant does not admit that Marsh is prior art, and reserves the right to swear behind it at a later date. Nevertheless, Applicant respectfully submits that the claims are distinguishable over Young in view of Ohga, Metz and Marsh for the reasons argued below. Further, Applicant notes that claims 7, 14, 20, 26, 27, 33, 34, 37, 38, 41 and 42 were cancelled in the response filed September 24, 2001.

Applicant respectfully traverses the rejection, because the cited art does not present a *prima facie* case of obviousness with respect to the amended claims. In order to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The

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teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that the combination of Young, Ohga, Metz and Marsh fails to teach or disclose each and every element of Applicant's amended claims. Additionally, there is no proper motivation to combine the cited art as suggested in the Office Action.

An example of an element not found in Applicant's claims is found in independent claim 1, which recites "a user initiated scheduling process operable for determining a scheduled time and channel for an in-band data broadcast, wherein the in-band data broadcast comprises electronic program guide data." Independent claims 9, 15, 16, 21, 25, 32, 36, and 40 each recite similar language. Applicant agrees with the Office Action that Young does not teach that a user initiates scheduling the download of EPG data. However, Applicant notes that in the rejection of claim 1, the Office Action states on page 3:

"the claimed limitations reciting "in-band data broadcast" is broad enough to read on the system described in Young, wherein the in-data [sic] may be broadcast over a conventional CATV system utilizing a conventional frequency channel, such as a 6 MHZ channel (col. 23, lines 7-15). "In-band" data broadcasts include broadcasts that utilize any or all portions of a frequency channel".

Applicant respectfully disagrees. While Applicant recognizes that limitations from the specification are not imported into the claims, it is also true that an Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Applicant has consistently used the term "in-band data" such as an electronic program guide (EPG), stock data, sports scores etc. to differentiate from audio and video content. The structure of such in-band data (as used by Applicant) is different from audio and video content. Therefore, the term "in-band" data is not as broad as suggested by the Office Action.

The Office Action states that Metz teaches the recited language. Applicant respectfully disagrees. As correctly noted in the Office Action, Metz teaches that executable software comprising an operating system for a set top box can be downloaded to the set top box.

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Nowhere does Metz teach or disclose user initiated scheduling of an in-band data broadcast comprising EPG data. In addition, the software application upgrade in Metz is not scheduled as the term is used in Applicant's specification. Metz merely teaches that the software upgrade can be programmed to occur after a time interval since a previous upgrade, or based on the number of power on/off cycles (see column 9, lines 20-30). Neither automatic mechanism schedules a download for a particular time as occurs in Applicant's claimed invention. The manual upgrade mechanism does not schedule an upgrade, rather it triggers the upgrade to occur at the time the upgrade option is selected. As a result, Metz does not teach the recited language. Applicant has reviewed the other cited references and can find no teaching of the recited language. Therefore the cited references, alone or in combination, do not teach each and every element of Applicant's claims. Thus a *prima facie* case of obviousness does not exist with respect to claim 1, 9, 15, 16, 21, 25, 32, 36, and 40. Applicant respectfully requests the withdrawal of the rejection of claims 1, 9, 15, 16, 21, 25, 32, 36, and 40.

Claims 2-5, 10-13, 17-19, 22-23, 29-30 and 41-45 each depend from one of the independent base claims discussed above. Each of these claims therefore inherits the elements of their respective base claim, including recitations directed to user initiated scheduling of the download of in-band data, including EPG data; and add further patentable distinctions. These dependent claims are therefore allowable for the same reasons as discussed above with respect to their base claims.

Additionally, the Office Action states on page 5 that "it was notoriously well known in the art of VOD programming for a user to order a particular broadcast program, at a particular time, over a particular channel..." Applicant respectfully disagrees with the statement. VOD (Video on Demand) systems provide the ability to instantaneously view program content, there is no scheduling involved, nor is there a need for scheduling. Applicant respectfully requests that the Examiner provide a reference supporting the statement.

Even if Young in view of Ohga, Metz and Marsh taught each and every element of Applicant's claims (which is not admitted), no proper motivation to combine the references exists. The Office Action must show a suggestion or motivation, either in the references

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themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. M.P.E.P. 2143.01. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine the reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002). Mere conclusory statements do not fulfill the Office Action's burden. *Id.* The court in *Lee* also stated that "[t]his factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority."

With respect to the motivation to combine Young and Ohga with Metz, Applicant respectfully submits that the Office Action has not provided such evidence or explanation for a suggestion or motivation to combine. Instead, the Office Action merely makes the conclusory statement that the combination of Young with Metz was obvious to one of ordinary skill in the art at the time the invention was made because of "the improvement of providing a more customized process for downloading the applications." Applicant respectfully submits that the Office Action has not provided objective evidence and authority for a suggestion or motivation to combine the references. Applicant respectfully requests the withdrawal of the rejection of claims 1-5, 9-13, 15-19, 21-23, 29-30, 32, 36 and 40-42.

Claim 6 was rejected under 35 USC § 103(a) as being unpatentable over Young, Ohga, Metz and Marsh, in view of Yoshinobu (US 5,686,954).

Applicant respectfully traverses the rejection because the cited art does not teach or suggest each and every element of Applicant's claims. Claim 6 depends from claim 1, and therefore inherits the recitation directed to a user initiated scheduling process operable to determine a scheduled time for downloading in-band data. As discussed above, none of Young, Ohga, Metz or Marsh teach or suggest the recited language. In addition, Applicant has reviewed Yoshinobu and can find no teaching or suggestion of a user initiated scheduled download. Therefore none of, Young, Ohga, Metz, Marsh or Yoshinobu, alone or in combination, teach

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each and every element of Applicant's claims. The Examiner is therefore respectfully requested to withdraw the rejection of claim 6.

Claims 28, 35, 39 and 43 were rejected under 35 USC § 103(a) as being unpatentable over Young, Ohga, Metz and Marsh, in view of Lajoie (US 5,850,218). Claims 28, 35, 39 and 43 each inherit recitations from their respective base claims related to user initiated scheduling of the download of in-band data, including EPG data. As discussed above, none of Young, Ohga, Metz or Marsh teach or suggest such user initiated scheduling. Further, Applicant has reviewed Lajoie and can find no teaching or suggestion of such user initiated scheduling. The Examiner is respectfully requested to withdraw the rejection of claims 28, 35, 39 and 43.

Claim 44 was rejected under 35 USC § 103(a) as being unpatentable over Young, Ohga, Metz and Marsh, as applied to claim 1 above, and further in view of Klosterman (US 5,550,576). Applicant respectfully traverses the rejection because the cited art does not teach or suggest each and every element of Applicant's claims. Claim 44 depends from claim 1, and therefore inherits the recitation directed to a user initiated scheduling process operable to determine a scheduled time for downloading in-band data. As discussed above, none of Young, Ohga, Metz or Marsh teach or suggest the recited language. In addition, Applicant has reviewed Klosterman and can find no teaching or suggestion of a user initiated scheduled download. Therefore none of, Young, Ohga, Metz, Marsh or Klosterman, alone or in combination, teach each and every element of Applicant's claims. The Examiner is therefore respectfully requested to withdraw the rejection of claim 44.

Additionally, with respect to each of the rejections discussed above, Applicant further notes that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. The Examiner must also recognize and

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consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). Finally, the Examiner must avoid hindsight. *Id.* The Examiner cannot use the Appellant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991). The Office Action uses no fewer than four, and usually five references in the rejection of each grouping of claims. This is highly suggestive that the Examiner is using Applicant's structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicant's claimed invention. Further, the use of individual elements from four or five references suggests that the Examiner is merely considering whether the differences are obvious, not the invention as a whole.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

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Respectfully submitted,

THEODORE D. WUGOFSKI

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6954

Date Sept. 10, 2002

By

Rodney L. Lacy  
Rodney L. Lacy  
Reg. No. 41,136

The undersigned hereby certifies that this correspondence is being transmitted via facsimile (FAX NO. 703-872-9314) to: Box AF, Commissioner of Patents, Washington, D.C. 20231, on this 10 day of September, 2002.

Candis B. Buending

Name

Signature